

REMARKS

Claims 1-60 are pending in the present application. Applicants thank the Examiner for the allowance of claims 1-15, 19, 21, 24 and 29-50 and 53-60 (not claims 29-60 as stated on page 1 of Paper No. 9, Office Action mailed 5/20/2003). Claims 16-18, 20, 25-28, 51 and 52 are rejected. Claims 23-24 (not claims 22-23) are objected to. New claims 61-64 are added and these claims are directed to pharmaceutical composition comprising the novel substituted 2-(2-pyridylmethyl)sulfinyl-1H-benzimidazoles (i.e., omeprazole, lansoprazole, pantoprazole and rabeprazole that contains less than about 4.5% sulfone). No new matter is introduced. Reconsideration and withdrawal of the rejection and objection are respectfully requested.

Applicants appreciate the Examiner's withdrawal of her objections to claim 8 under 37 C.F.R. 1.75 (c), claims 20, 25-28 under 35 U.S.C. § 112, second paragraph, claims 25-28 under 35 U.S.C. § 102(b), and claims 1-3, 8, 10, 13, 14, 15-21 under 35 U.S.C. § 103(a).

It is noted that claims 51 and 52 (which recite the trademark term "OXONE") are listed among the properly allowed claims. Moreover, it appears that claims 23 and 24, not claims 22 and 23, are more properly objected to because claims 23 and 24 depend on claim 22.

Rejection of Claims 16-18, 20, 25-28

Claims 16-18, 20 and 25-28, stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

35 U.S.C. § 112, Second Paragraph Rejection (Old Rejection)

The Examiner maintains her allegation that claims 16-18 are indefinite because the claims contain the trademark term "OXONE."

MPEP 608.01(v) provides:

Names used in trade are permissible in patent application if:

- (a) their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim; or
- (b) in this country, their meanings are well-known and satisfactorily defined in the literature.

Contrary to the Examiner's assertion that "neither condition is met," Applicants submit that at least condition (b) is met.

Applicants respectfully submit that the meaning of the trademark term "OXONE" is well-known and satisfactorily defined in the literature. It should be noted that the "OXONE" trademark was registered by Du Pont on March 24, 1959 (Registration No. 0675834) and the product has been in commerce (thus available to the public in the U.S.) since March 4, 1957. The trademark term is well-known to one skilled in the art in this country for over forty years. Applicants submit that the trademark term OXONE is satisfactorily defined in the literature for the reasons set forth below:

i) the trademark term "OXONE" is defined in the "The Condensed Chemistry Dictionary" (Attachment 1) as a solid containing potassium peroxymonosulfate as early as in the 1966 Edition which provides:

"OXONE" Trademark for an acidic, white, granular free-flowing solid containing the active ingredient potassium peroxymonosulfate; readily soluble in water; 1% solution has pH of 2-3. Minimum active oxygen content 4.5%. Strong oxidizing agent.

The source of "OXONE" is clearly indicated to be E.I. du Pont de Nemours & Co.;

ii) the trademark term "OXONE" is also defined in the "Grant & Hackh's Chemical Dictionary" (Fifth Edition, 1987) (Attachment 2);

iii) the trademark term "OXONE" has also been described in the scientific literature. An exemplary article is by Kennedy Richard J., *et al.* in the Journal of Organic Chemistry (1960), 25, 1901-6, entitled "Oxidation of organic substances by potassium peroxymonosulfate." (Attachment 3).; and,

iv) in fact, the trademark term "OXONE" is sufficient, precise and definite that the USPTO has consistently issued patents in which claims recite the trademark term "OXONE." Using the search term (ACLM/OXONE) in the USPTO patent database, Applicants were able to identify at least 30 U.S. issued patents, all of which use the trademark term "OXONE" in their claims. Exemplary patents include U.S. Pat. No. 6,143,909 (claims 19 and 25) and U.S. Pat. No. 4,975,109 (claim 24) all of which recite "OXONE" as part of their claims. A copy of these patent documents are submitted herewith (Attachment 4).

For at least the foregoing reasons, Applicants respectfully submit that at least the condition (b) provided in MPEP-§ 608.01(v) is fully met. Applicants respectfully urge the Examiner to consider the trademark term "OXONE" as having well-known meanings and satisfactorily defined in literature and to exercise uniformity with USPTO precedents. The trademark term "OXONE" should be permissible in claims 16-18, 20, 25-28 and that the rejections of these claims should be withdrawn.

35 U.S.C. § 112, Second Paragraph Rejection (New Rejection)

The Examiner rejected claims 25-28, alleging that these claims are indefinite because it is not clear if a compound or composition is being claimed, since omeprazole, lansoprazole, pantoprazole, and rabeprazole are being claimed in each of these claims individually having less than about 4.5% sulfone. According to the Examiner, a compound cannot consist of more than one compound.

Applicants submit that claim 1 describes a process of preparing a genus of substituted 2-(2-pyridylmethyl)sulfinyl-1H-benzimidazoles by selective oxidation. The genus encompasses many species of compounds of which omeprazole, lansoprazole, pantoprazole and rabeprazole are exemplary compounds. Claims 25-28 respectively recite individual benzimidazole compounds characterized by having less than about 4.5% sulfone as prepared by the processes recited in the independent claims.

For at least the foregoing reasons, Applicants respectfully submit that the rejections of claims 25-28 should be withdrawn.

35 U.S.C. § 112, Second Paragraph Rejection (New Rejection)

The Examiner rejected claims 51 and 52 and alleged that they are indefinite because the trademark term "OXONE" is indefinite.

Applicants submit the same reasoning as detailed above and believe that the trademark term "OXONE" is definite. Accordingly, Applicants urge that this rejection should be withdrawn.

Objection To Claims 22-23

Claim 22 is an independent claim upon which claims 23-24 depend. Claim 22 recites the trademark term "OXONE" and the Examiner has rejected the claims reciting this term. Applicants believe the Examiner may have meant to object to claims 22 to 24 and not claims 22 and 23. Applicants believe that the 35 U.S.C. § 112 rejection of all these claims is now

overcome in light of the foregoing arguments. Accordingly, the objection is believed to be moot.

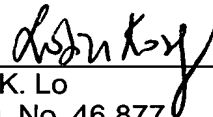
CONCLUSION

Applicants respectfully request reconsideration and withdrawal of the rejections set forth in the May 20, 2003 Office Action. Allowance of all the rejected and objected to claims as well as the newly added claims is hereby requested. The Examiner is invited to contact the undersigned attorney at (212) 908-6018 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON

Dated: November 20, 2003

By: 
Siu K. Lo
Reg. No. 46,877

One Broadway
New York, NY 10004